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IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

Supreme Court, U.S.
FILED
JUN 19 1972
E. ROBERT SEAVER, CLERK

No. 71-1457

MONSANTO COMPANY, *Petitioner,*

v.

ROHM & HAAS COMPANY, *Respondent.*

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF THE AMERICAN PATENT LAW ASSOCIATION IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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No. 71-1457

MONSANTO COMPANY, *Petitioner,*

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ROHM & HAAS COMPANY, *Respondent.*

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The American Patent Law Association respectfully moves for leave to file the annexed brief *amicus curiae* in connection with the petition in the captioned case for writ of certiorari to the United States Court of Appeals for the Third Circuit.

Consent to the filing of that brief was sought from both parties through their attorneys of record.* The

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* Copies of the letter requesting consent and the replies of petitioner and respondent are reproduced as Exhibits 1, 2 and 3, respectively to this motion.

replies appear to *amicus* to make this motion necessary under Rule 42 of this Court.

The interest of the American Patent Law Association is two-fold. Its first interest is in the standards of conduct required of its members, who are for the most part lawyers in active practice, in presenting facts in patent matters to courts and administrative agencies, and, most particularly, in proceedings before the United States Patent Office. Its second interest is in the standards of conduct in like circumstances required of its members' clients.

This motion and the attached brief are submitted because the petition in this case raises issues important to the administration of the patent laws and those who represent persons affected thereby. These are issues of public import which the parties cannot adequately address directly within the private scope of their pleaded controversy.

The decision below affirmed a trial court judgment holding petitioner's patent invalid on the ground that certain conduct in its procurement amounted to a fraud on the United States Patent Office. Not adverted to by the parties or by the Court was whether the cited conduct of the attorney and his client was a violation of any Patent Office rule or prescription of ethical standards. *A fortiori,* the decision never reached the necessarily related question whether such conduct being denominated "fraud" would be grounds for expulsion from the bars of all courts, including this Court.

The Association has a deep concern for all the standards of conduct required of its members, and all patent attorneys, in their practice before the courts, the administrative agencies, and, especially, before the

United States Patent Office. It submits this motion and the accompanying brief, because, in this law suit between private parties, there is presented a matter of great concern to all practicing patent lawyers, and to all courts and agencies before whom these lawyers appear.

Respectfully submitted,

SIDNEY NEUMAN, *President*
AMERICAN PATENT LAW ASSOCIATION
2001 Jefferson Davis Highway
Arlington, Virginia 22202

By _____
W. BROWN MORTON, JR.
JOHN T. ROBERTS
1054 31st Street, N. W.
Washington, D. C. 20007
Attorneys

Exhibit 1 to Mot[redacted]

[Letterhead of Morton, Bernard, Brown, Roberts & Sutherland]

May 25, 1972

C. Frederick Leydig, Esq.
One IBM Plaza
Chicago, Illinois 60611

Arthur G. Connolly, Esq.
Farmers Bank Building
Wilmington, Delaware 19899

Gentlemen:

I have been selected by the Board of Managers of the American Patent Law Association to prepare and file a brief on behalf of the Association *amicus curiae* urging the Supreme Court of the United States to grant the petition for a writ of certiorari in *Monsanto Company* v. *Rohm & Haas Company* (No. 71-1457).

This brief will, of course, express no opinion about the merits of the patent involved, but it will urge the deep concern of the Association over the current uncertainties and conflicts existing as to a lawyer's duty in representing a client in a patent matter with respect to evaluating and presenting scientific evidence, including the state of the art and the relationship of the client's claims or defenses thereto. It will ask the Supreme Court to grant the petition for the purpose of authoritatively defining that duty irrespective of its resolution of the specific private controversy in the case.

Your consent to the filing of the proposed brief *amicus curiae* is requested.

Very truly yours,

WBM/emk W. Brown Morton, Jr.

c.c. Board of Managers, APLA

Exhibit 2 to Motion

[Letterhead of Wolfe, Hubbard, Leydig, Voit & Osann, Ltd.]

May 30, 1972

W. Brown Morton, Jr., Esq.
Morton, Bernard, Brown, Roberts & Sutherland
1054 Thirty-First Street, Northwest
Washington, D. C. 20007

Dear Mr. Morton:

Re: Monsanto Company v. Rohm & Haas Company
(No. 71-1457)

On behalf of petitioner *Monsanto Company*, I am pleased to consent to the filing of a brief *amicus curiae* by the American Patent Law Association.

Very truly yours,

WOLFE, HUBBARD, LEYDIG, VOIT
& OSANN, LTD.
By /s/ C. FREDERICK LEYDIG

CFL/kh

cc: Arthur G. Connolly, Esq.
Farmers Bank Building
Wilmington, Delaware 19899

Exhibit 3 to Motion

[Letterhead of Connolly, Bove & Lodge]

May 30, 1972

W. Brown Morton, Jr., Esquire
Morton, Bernard, Brown, Roberts
& Sutherland
1054 31st Street, N.W.
Washington, D. C. 20007

Dear Brown:

This is in reply to your letter of May 25th requesting consent to the filing of an amicus brief on behalf of the American Patent Law Association in *Monsanto* v. *Rohm & Haas*. Before discussing your letter with Rohm & Haas, I would appreciate a statement as to whether you have actually studied and are familiar with the trial record and the complete decisions of the two lower courts.

I am not at all concerned with whether you agree or disagree with Rohm & Haas' position. Intelligent and informed disagreement is always helpful, particularly in such a changing field as we are here dealing with. However, unless the amicus brief is prepared by one who is thoroughly acquainted with the case, his brief is likely to be a disservice rather than a help to the Court and the patent bar.

As soon as I receive your reply, I shall submit it to Rohm & Haas with my recommendation as to whether we should consent to the filing of this brief.

Sincerely,

/s/ ART

AGC: mcr

cc: Board of Managers, APLA
C. Frederick Leydig, Esq.

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No. 71-1457

MONSANTO COMPANY, *Petitioner,*

v.

ROHM & HAAS COMPANY, *Respondent.*

BRIEF AMICUS CURIAE OF THE AMERICAN PATENT LAW ASSOCIATION URGING THE GRANT OF A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

The American Patent Law Association has approximately 3800 members who are lawyers practicing throughout the United States in private law firms, legal departments of corporations, and in the government. The Association's members represent approximately half of the patent lawyers in the country, and they engage in all phases of patent law.

The American Patent Law Association, as *amicus curiae,* respectfully urges the grant of a writ of cer-

certiorari to the United States Court of Appeals for the Third Circuit in this case for the reason that the decision below throws in doubt the parameters of conduct required by professional ethics of attorneys representing clients in patent matters. Although this doubt must reach to an attorney's duty in presenting facts in such matters, whether in the courts or before administrative agencies, the specific problem below, and at its most urgent, concerns the standards required in representing applicants before the United States Patent Office. The ruling below appears to the Association to involve patent attorneys with an ill-defined requirement of loyalty to two masters. This creation of a professional dilemma, with potentially catastrophic consequences after a good-faith, but unwise, resolution of it seems to the Association unnecessary and inconsistent with, if not directly contrary to, the heretofore unquestional standards of legal ethics.

THE QUESTION AMICUS URGES

Is it proper to denominate as "fraudulent" the conduct of an attorney representing an applicant for a patent before the Patent Office who presents experimental scientific evidence by selecting from the whole body of related evidence that portion which he reasonably urges is the portion material to the patentability of his client's invention under the governing law as he argues it?

Especially:

Is such conduct properly judicially branded as "fraudulent" without a specific finding of intentional or knowing deception?

Is there here a higher or different standard of conduct than that governing the presentation of

experimental scientific evidence before a court or another administrative agency? If so, what?

Can a court properly impeach an attorney by asserting that he committed fraud on the Patent Office and thus forfeit his client's patent without solemnly accepting the obligation of finding every element that establishes a basis for (1) disciplinary action against the attorney[1] and (2) malpractice recovery by the client?

The foregoing issues, *amicus* submits, are raised by the decision of the Court below. The decision below in terms affirmed the District Court's holding of patent invalidity, but on such limited grounds as necessarily to bring into question both the standard expected of an attorney representing an applicant for patent before the United States Patent Office and the related question whether that standard is compatible with the recently promulgated Code of Professional Responsibility which sets up the ethical requirements of advocacy of a client's cause within the framework of honor, honesty, and diligence required to make the legal system workable.

ARGUMENT

The Facts:

On or about November 9, 1967, Arnold H. Cole, a Monsanto patent attorney filed, in the application for the Huffman patent in suit, an argument for patentability supported by the affidavit of a Dr. Husted. This

[1] *E.g.*, under Rule 8 of this Court, which provides in pertinent part: "Where it is shown to the court that any member of its bar * * * has been guilty of conduct unbecoming a member of the bar of this court, he will be forthwith suspended from practice * * *".

argument and affidavit resulted in the allowance of the patent by the examiner.

Dr. Husted had conducted other tests not set forth in the affidavit which had been reported to the Monsanto patent attorney. On the basis of this additional information, and on the law as it saw it, the District Court held the patent invalid as obvious. The Association, of course, has no interest in, and takes no position on, these issues of fact and law so crucial to the parties. Further, *amicus* has taken and will take no position on whether the actual selection of the data to report meets a properly-formulated standard of ethical conduct.

Monsanto, of course, agreed that its attorney had acted intentionally and not inadvertently in selecting the material for inclusion in the affidavit, but asserted that Mr. Cole's decision was based on both a subjectively good faith view and an objectively correct view that the omitted evidence was not material. The Association takes no position on the substantive patent law questions thus involved.

Morover, had the District Court unequivocally concluded that evidence had been withheld with a recognition[2] of materiality and an intent to deceive the Patent Office, then this Association would have left the parties to their proofs.

The District Court, however, concluded there was "fraudulent" conduct on behalf of the applicant, Monsanto, and necessarily, on the part of the attorney pro-

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[2] The District Court did not question Mr. Cole's veracity when he testified about his subjective view of materiality. (App. 78). [References in this style are to the Appendix to the Petition for a Writ of Certiorari.]

fessionally, even if "Monsanto did not intend to mislead the Patent Office." (App. 102-103).

Why Amicus Urges the Grant of the Writ

The District Court seemingly prescribes, as a standard of conduct required of applicants and their attorneys, that *all* evidence that could reasonably be argued to be even marginally material must always be submitted, analogizing to the requirements for an SEC disclosure statement (App. 63, 80-81).[3] Thus, apparently, a "fraud" may be committed by "withholding" evidence albeit the evidence not produced is later conceded to be of no consequence to the patentability of the involved invention. (App. 97).

The majority in the Court of Appeals affirmed the decision on the sole issue of misrepresentation. (App. 5). The majority opinion treats neither the matter of the subjective good faith of the attorney nor the existence of doubt as to materiality as pertinent. Indeed, the Court discarded good faith as an element in the appraisal of the ethics of challenged conduct, when it resolved (App. 11) a hotly contested legal rule about obviousness, citing *Application of Papesch,* 315 F. 2d 381 (C.C.P.A. 1963), in order to find the omitted evidence material. It then proceeded to affirm the Dis-

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[3] Such is not a standard recognized by the Patent Office.

The statutory standard of patent application disclosure (35 U.S.C. § 112) requires a statement in "full, clear, concise, and exact terms". On its face, this requires selectivity in draftsmanship, not mere exhaustive recitation. This Association does not believe that there is any warrant for any other standard of disclosure at any stage of the patent prosecution process.

Patent Office Rule 346 provides in pertinent part:

> "The signature of an attorney * * * to a paper * * * or the * * * presentation of any paper by him, constitutes a certificate * * * that to the best of his knowledge, information, and belief, there is good ground to support it * * *."

trict Court's finding that the party and, *amicus* submits, necessarily the attorney professionally as well, were guilty of "fraud" in believing a different legal rule and acting accordingly.

Amicus submits that the standards formulated by the District Court and affirmed by the Court of Appeals state a requirement of uncritical disclosure, and, indeed, prescience, for attorneys presenting scientific experimental evidence, especially before the United States Patent Office, which departs from the standards set for the Bar generally[4] before either administrative agencies or the Courts, and, indeed, is inconsistent with both the duty of zealous representation owed by all attorneys to their clients and the sifting and refining role all advocates owe the tribunals before which they practice.

1. *Amicus* submits that a charge of fraud on the United States Patent Office is almost inevitably directed at the conduct of an attorney and that, as his case must stand or fall with his client's case, so must his client's case be judged by the standards applicable to him. This Court's decisions in *Hazel-Atlas Glass Co.* v. *Hartford-Empire Co.,* 322 U.S. 238 (1944) and *Kingsland* v. *Dorsey,* 338 U.S. 318 (1949) make that clear.

2. The United States Patent Office, by its Rule 344, expressly adopts the Code of Professional Responsibility of the American Bar Association, as amended February 24, 1970, to govern the conduct of practitioners before it, supplemented by Rule 346, quoted

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[4] The Code of Professional Responsibility adopted by the American Bar Association as of February 4, 1970. This Code has been adopted by *amicus* and has been adopted officially in 42 states and the District of Columbia.

supra, as to the "certificate" of an attorney. *Amicus* agrees that it is an ethical obligation of all attorneys not knowingly to advance false evidence for the purpose of deceiving a tribunal (Code, Canon 7) and to present no paper that is not supported by good grounds to the best of their knowledge, information, and belief. However, no breach of either duty appears to be involved in the ruling of the majority of the Court of Appeals.

3. *Amicus* submits that all attorneys are obliged to both their clients and to the tribunal to use their best professional judgment in presenting and arguing the governing laws and the evidence material to the application of those laws (Code, Canons 5, 6, and 7). This Court should grant certiorari in this case since the standard apparently laid down by the majority below for the conduct of parties and attorneys before the Patent Office is at variance with the requirements for attorneys generally, and, indeed, with the stated requirements of the United States Patent Office.

4. *Amicus* submits that all attorneys have a duty, in the expeditious conduct of proceedings, to their clients, to the tribunals, and to the public, to winnow the wheat from the chaff, that is, to present the evidence material to, and determinative of, the issues and to forego presentation of evidence neither material nor determinative.

5. The Patent Office has evinced no desire for a proliferation of paper such as a prudent follower of the decision below might (or must) submit to avoid a charge of fraud. This Court should accept this case for review since the decision below appears to require an attorney before the United States Patent Office to present *all* evidence, material or not, and thus to

finesse his obligation of exercising professional legal judgment. It is submitted that such a rule, unclarified, opens a Pandora's box of problems involving possible malpractice charges and disciplinary proceedings against the Association's members.

Where would such a member stand between his duty to provide effective representation and a newly imposed duty to collect and report all data?

CONCLUSION

For the foregoing reasons, the interests of the public in a clear definition of the twin requirements of ethical conduct and effective advocacy by the patent bar should be promoted by *granting* the petition for a writ of certiorari.

Respectfully submitted,

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